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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,558	12/05/2003	Daniel James Dickinson	AN15D1	9984

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EXAMINER

SALDANO, LISA M

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Km

Office Action Summary

Application No.

10/728,558

Applicant(s)

DICKINSON ET AL.

Examiner

Lisa M. Saldano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 13-18, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-18, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The amendment filed on 7/29/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "As better shown in Figures 1 and 2, the front with Wa of the snapping segment...is substantially equal to the distance between the respective opening sides 30b and 32b."

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, the amended claims 1 and 13 recite limitations wherein snapping segments have a "width which is substantially equal to the distance between the respective first opening side and second opening side." The applicant, in his most recent amendment, also amended the specification to include these limitations. Furthermore, the drawings as originally filed do not sufficiently illustrate the width of the snapping segment to definitively convey that the applicant had possession of the claimed invention as originally filed.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6, 13-18, 25 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,726,418. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,726,418 claims a spring fastener with a head portion

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and an elastic body. U.S. Patent No. 6,726,418 claims that the elastic body has at least one front portion and at least one back portion, as well as side portions with front and back snapping segments. U.S. Patent No. 6,726,418 recites all the limitations claimed by the applicant in the present invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 13-15, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell et al (5,774,949) in view of Smith (5,725,343) and Kost (2,223,622).

Regarding claim 1, Cornell et al disclose a trim clip 100 comprising a head portion 8 having an upper side with an engagable hole 22 for a securing member 26 (see Fig.1). The head portion 8 also has a lower side (see Fig.1). The trim clip also comprises a body portion extending from the lower side of the head portion extending at a substantially right angle with respect to the head portion. The body portion comprises a front body portion and back body portion made of arms 12, 12' and bridging portions 20, 20'. The front and back body portions also have openings or windows 17,17' that have opening tops, opening bottoms and opening sides. The windows

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17,17' each have a side body portion 10,10' on each opening side (see Fig.2). Cornell et al also disclose front and back snapping segments made along arms 12,12' connected to the front and back body portions in the vicinity of the opening bottom wherein the snapping segments comprise a free engagement end 15,15'. The front snapping segments are disposed along the front opening.

Regarding claims 2 and 14, Cornell et al disclose the trim clip as disclosed above, wherein the trim clip comprises a secondary engagement section comprising spaced-apart prongs 16,16'.

Regarding claims 3, 15, 25 and 26, Cornell et al disclose the trim clip as disclosed above wherein the side body portions comprise an inner surface that is capable of functioning as a tertiary segment.

Regarding claim 13, Cornell et al disclose the trim clip as disclosed above wherein the clip is used on an automobile body (see column 1, lines 5-10) to connect trim 24 and resilient foam material 28 to the frame of the automobile or vehicle.

However, Cornell et al fail to disclose an elastic body disposed at least under the lower side of the head portion. Please note, however, that Cornell et al do disclose resilient foam material 28 included in the assembly of trim 24 onto frame (see Fig.5 and column 3, lines 16-21). Cornell et al disclose that the inclusion of the foam assists in preventing loosening of the assembly. Cornell also fails to disclose that the snapping segments have a width that is substantially equal to the distance between the respective first opening side and second opening side.

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Smith discloses a sealing fastener for connecting a first object 11 to a second object 13. The sealing fastener includes an elastic body 7 that is compressed during installation of the fastener. Smith discloses that, once completely installed, the elastic body provides sealing from water leakage as well as reduction in squeaking noises due to vibrations.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the elastic body under the head of the clip of Cornell et al, as taught by Smith, because the elastic body compresses and reduces the effects of vibrations in the assembly, which ultimately lead to loosening of the assembly. Cornell et al provide this effect by putting an elastic body (foam 28) over the head of the clip. Smith achieves the same effect by providing an elastic body under the head of the clip.

Kost discloses a trim fastener (see Fig.1) comprising a pair of snapping segments or fingers 24 (see column 2, lines 13-15). As broadly illustrated by the applicant of the present invention, Kost illustrates that the snapping segments have a width that is substantially equal to the distance between the respective first opening side and second opening side (see Fig.1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide snapping segments on the invention of Cornell et al with a width that is substantially equal to the distance between the respective first opening side and second opening side, as illustrated by Kost, because the wider snapping segment provide a more secure connection at the snapping location.

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5. Claims 4-6 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell et al in view of Smith and Kost, as applied to claims 1-3 and 13-15 above in view of either Kuffel (5,759,004) OR Fischer (5,919,019).

Regarding claims 4-6 and 16-18, Cornell et al, Smith and Kost disclose the trim clip and sealing fasteners, respectively, as described above. Specifically, Cornell et al disclose front and back snapping segments made along arms 12,12' connected to the front and back body portions in the vicinity of the opening bottom wherein the snapping segments comprise a free engagement end 15,15'.

However, neither Cornell et al, Smith nor Kost explicitly disclose the use of anti-sliding sections or anti-opening sections on the free engagement ends of the snapping segments.

Kuffel discloses a push mount 10 for connecting a cable tie strap 26 to a mounting surface 30. The push mount comprises centering tabs 22 and reversely bent portions 20 or legs 18 that abut the underside of mounting surface 30 to retain the mount 10 in engagement with the mounting surface thereby providing an anti-opening section of the free engagement ends of the leg 18 (see column 2, lines 38-43).

Fischer discloses a mid-panel nut 10 securing a panel 14 to another apparatus 28. The nut comprises two extensions 40 with panel edge securing means 48, wherein the tip 50, 58 of the means 48 is provided with a good frictional surface such as with knurled or scored sections (see Figs. 2&5 and column 2, lines 47-50 and column 3, lines 43-48). Fischer discloses that the scored regions secure the nut 10 against lateral movement within a panel opening 18.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the anti-opening and/or anti-sliding portions taught by either Kuffel or Fischer on the

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trim clip of Cornell et al because the anti-opening and/or anti-sliding portions provide a means to further secure the clip in the opening of the panel thereby further securing the entire fastening arrangement, which serves the basic purpose of fastening elements that are intended to keep two objects connected to one another.

Response to Arguments

6. Applicant's arguments with respect to claims 1-6, 13-18, 25 and 26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. For example, the applicant amended the claims to include newly presented subject matter, specifically, snapping segments having a "width which is substantially equal to the distance between the respective first opening side and second opening side."

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa M. Saldano whose telephone number is 703-605-1167. The examiner can normally be reached on Monday-Friday, 8:30am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on 703-308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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